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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.  | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------|------------------|
| 10/821,107  | 04/08/2004  | Boris Mayer          | 30691/DP011          | 8993             |
| 4743  | 7590        | 09/05/2006           | EXAMINER             |                  |
| MARSHALL, GERSTEIN & BORUN LLP<br>233 S. WACKER DRIVE, SUITE 6300<br>SEARS TOWER<br>CHICAGO, IL 60606 |             |                      | BANGACHON, WILLIAM L |                  |
|   |             |                      | ART UNIT             | PAPER NUMBER     |
|   |             |                      | 2612                 |                  |

DATE MAILED: 09/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/821,107

Applicant(s)

MAYER ET AL.

Examiner

William L. Bangachon

Art Unit

2612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments [see Remarks], filed 7/7/2006, with respect to the specification and the drawings have been fully considered and are persuasive. The objection of the specification and drawings has been withdrawn.

2. Applicant's arguments have been fully considered but they are not persuasive.

The Examiner respectfully traverses applicant's argument that the action has not provided any factual support that Kakuta discloses a **"a control unit for controlling the operating unit, the control unit comprising an interface for flexibly associating the parcel boxes with the operating units"** [paragraph bridging pages 6 and 7; page 8, 2<sup>nd</sup> paragraph]. As shown in Figure 6, Kakuta discloses a central control unit (e.g. supervising center 201) for controlling at least two operating units (210), the central control unit (201) comprising an interface (202, 203) for flexibly associating the lockers (221) with the at least two operating units as described in col. 12, lines 14-28+; col. 16, lines 33-37; col. 18, lines 63-67+. The central control unit 201 not only controls the opening and closing of the door of the electronic parcel boxes, it also manages orders from customers using the electronic parcel boxes wherein convenience of the customer is further improved as described in col. 17, lines 55-63.

The Examiner respectfully traverses applicant's argument that **"any control unit disclosed in Kakuta does not flexibly associate parcel boxes with multiple**

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**operating units because all the parcel boxes are always associated with the same operating unit, and in other case Kakuta provides no parcel boxes”** [page 7, last sentence of 2<sup>nd</sup> paragraph]. As shown in Figure 6, Kakuta shows a central control unit (e.g. supervising center 201) for controlling at least two operating units (210), the central control unit (201) comprising an interface (202, 203) for flexibly associating the lockers (221) with the operating units as described in col. 12, lines 14-28+; col. 16, lines 33-37; col. 18, lines 63-67+. Obviously, the multiple lockers of Kakuta are a variation of parcel boxes because such lockers, shaped like boxes, can be used to contain parcels

In response to applicant's argument [page 8, 1<sup>st</sup> paragraph] that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., **“flexibly associating parcel boxes with operating units allows the central control unit to carry out a changeable allocation of parcel boxes to a different operating unit if one operating unit fails.”**) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). There is no indication in the claims that “flexibly associating parcel boxes with operating units” allows the central control unit to carry out a changeable allocation of parcel boxes to a different operating unit if one operating unit fails. In this case, the central control unit 201 of Kakuta not only flexibly opens and closes the door of the electronic parcel boxes, it also manages orders from customers using the electronic parcel boxes wherein convenience of the customer is further improved {col. 17, lines 55-63}. It would have been obvious to one of ordinary

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skill in the art, at the time of applicant's invention, that when an operating unit malfunctions, then parcel boxes should be associated with functioning operating units, which is done by either repairing the malfunctioning unit or replacing it with an operating unit that is functioning properly

***Claim Rejections - 35 USC § 112***

3. The rejection of claim 3 under 35 U.S.C. 112, second paragraph, is withdrawn.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 6,456,900 {Kakuta}.

With regards to claim 1, Kakuta teaches of an electronic parcel box system comprising:

(a) at least two operating units (e.g. settling terminal 210 shown in Figures 6 and 14) {col. 16, lines 25-32, lines 38-42; col. 18 lines 13-35+};

(b) a plurality of electronic lockers (221), several of which are associated with the operating unit (210) {col. 17, lines 8-19+; col. 18, lines 36-48+}; and,

(c) a central control unit (e.g. supervising center 201) for controlling the at least two operating unit (210), the central control unit (201) comprising an interface (202, 203) for flexibly associating the lockers (221) with the operating units {col. 12, lines 14-28+; col. 16, lines 33-37; col. 18, lines 63-67+}. In this case, the central control unit 201 not only flexibly controls the opening and closing of the door of the electronic parcel boxes, it also manages orders from customers using the electronic parcel boxes wherein convenience of the customer is further improved. Obviously, customers can

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range from personal to delivery companies such as the Post Office or FedEx {col. 17, lines 55-63}.

Although Kakuta does not disclose parcel boxes, it would have been obvious to one of ordinary skill in the art, at the time of applicant's invention that the lockers of Kakuta are an obvious variation of parcel boxes because such lockers, shaped like boxes, can be used to contain parcels.

In claim 2, although Kakuta do not disclose "the parcel boxes associated with a malfunctioning operating unit are associated with another operating unit", it would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, that when an operating unit malfunctions, then parcel boxes should be associated with functioning operating units, which is done by either manually repairing the malfunctioning unit or manually replacing it with an operating unit that is functioning properly.

Claim 3 recites the limitations of claim 1, further comprising:

(a) several electronic parcel box systems networked with each other according to claim 1. See Figure 7.

(b) a central database server 202 comprising memory 236 for storing data about the filling status of the parcel box systems and a transmitter 232 for transmitting the data; and,

(c) a device 200 for delivering postal parcels to individual electronic parcel box systems as a function of the filling status of the electronic parcel box systems.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Office Contact Information***

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to William Bangachon whose telephone number is (571)-272-3065. The Examiner can normally be reached on Monday – Thursday, 8:30 AM – 4:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Wendy Garber can be reached on (571)-272-7308. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300 for regular and After Final formal communications. The Examiner's fax number is (571)-273-3065 for informal communications.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.



William L. Bangachon  
Examiner  
Art Unit 2635

August 12, 2006



WENDY R. GARBER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

REPLACEMENT SHEET

Inventors: Mayer, et al.

Serial No.: 10/821,107

Sheet 1 of 12 Figure 1

APPROVED (FIG. 1-9)  
WJS 8/2/06

FIG. 1

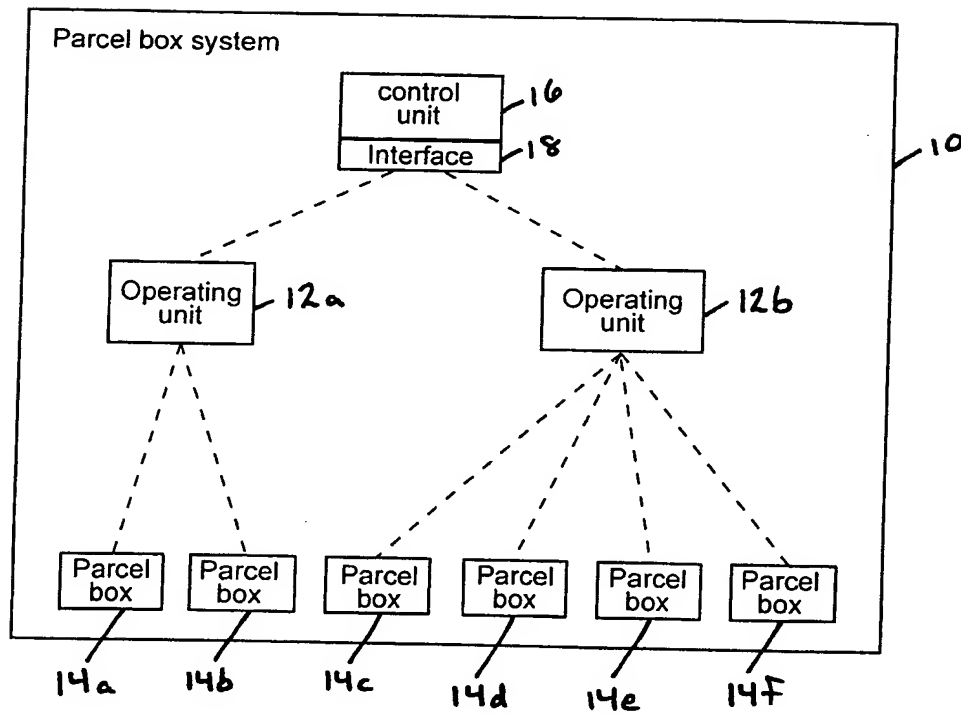


FIG. 2

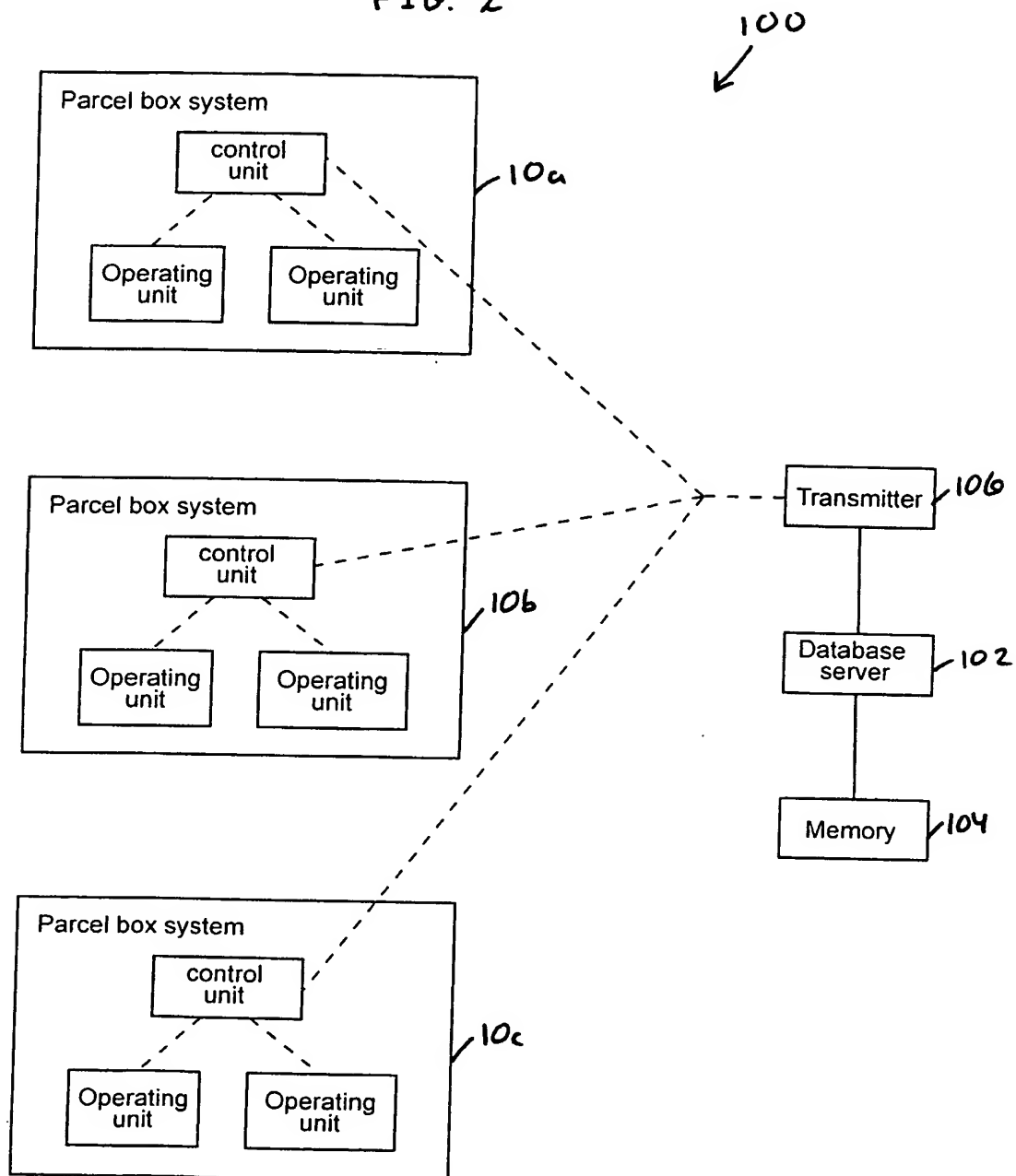


FIG 3

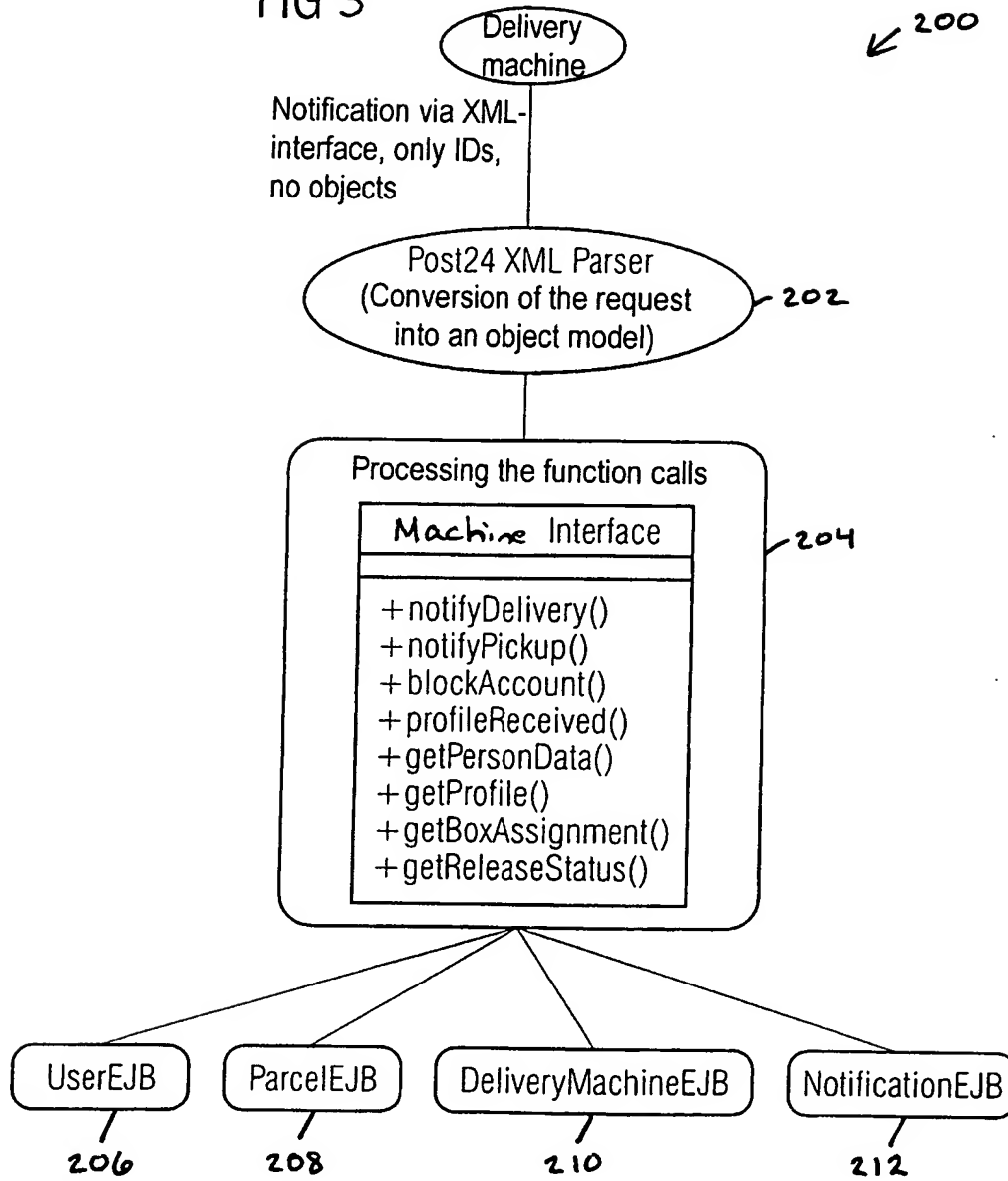
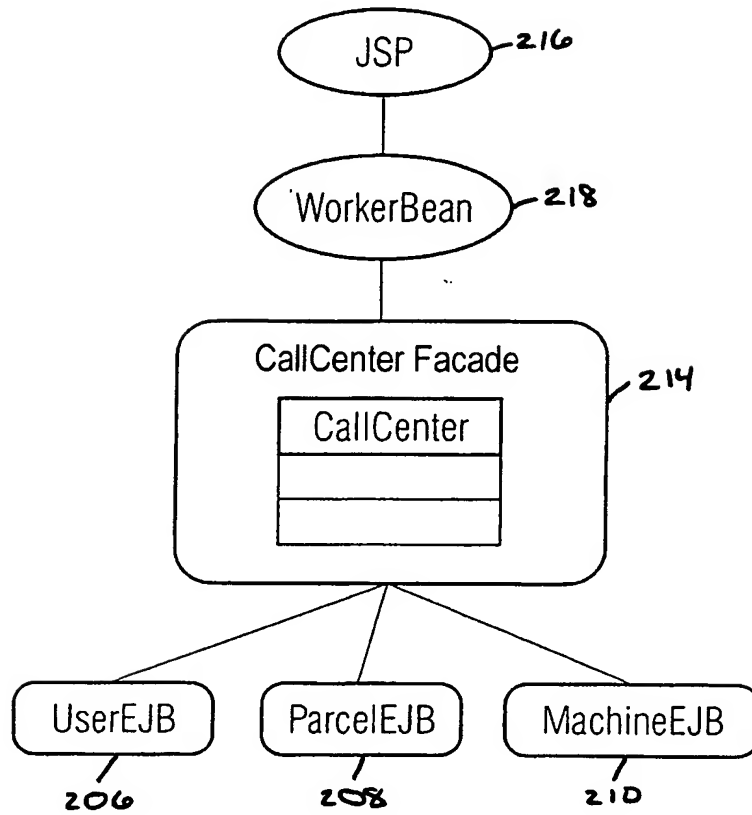


FIG 4



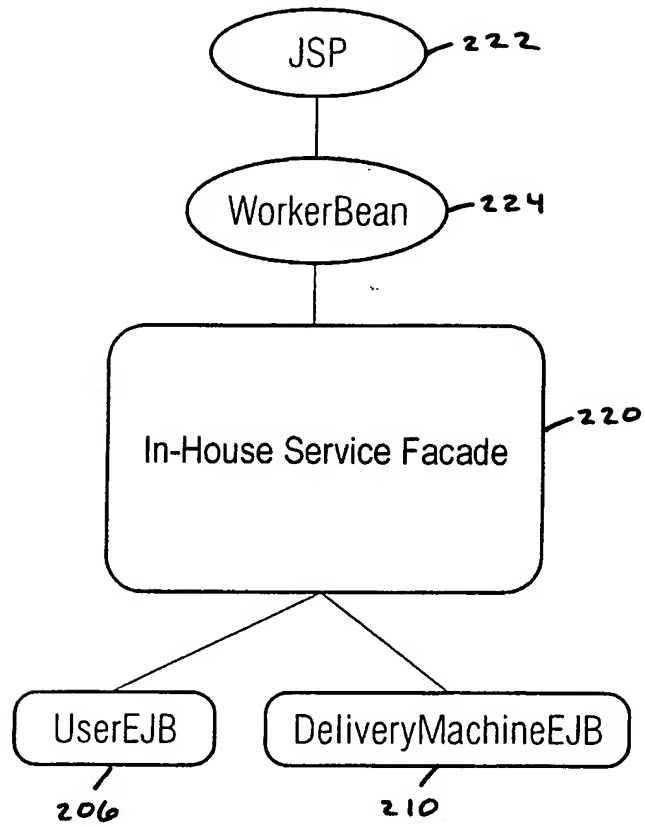
REPLACEMENT SHEET

Inventors: Mayer, et al.

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Sheet 5 of 12 Figure 5

FIG 5



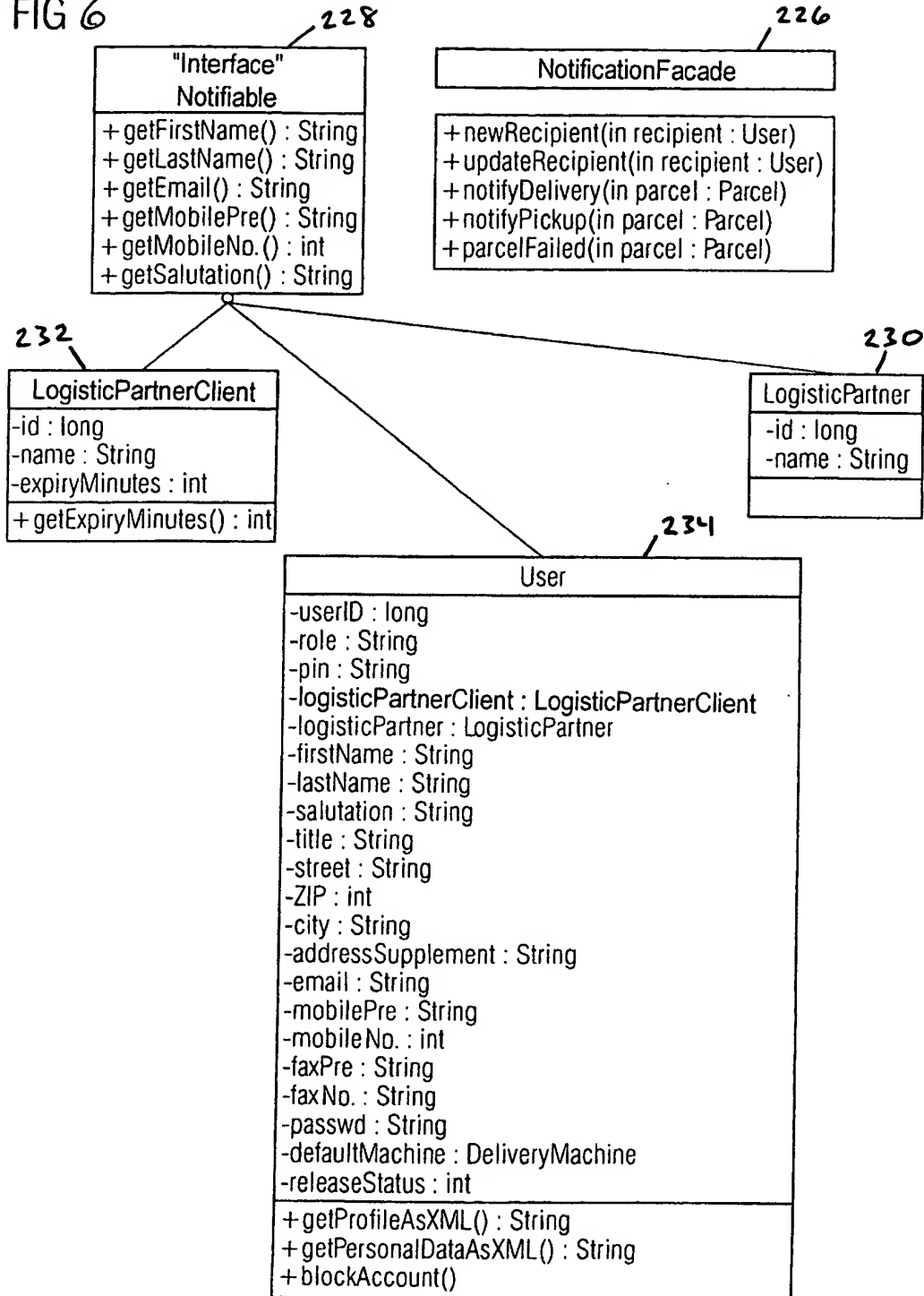
# REPLACEMENT SHEET

Inventors: Mayer, et al.

Serial No.: 10/821,107

Sheet 6 of 12 Figure 6

FIG 6



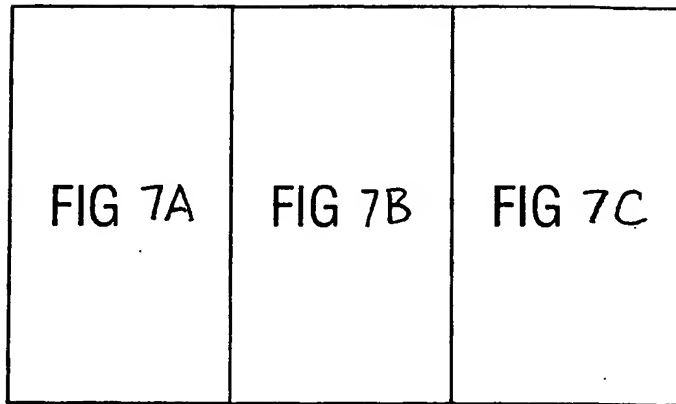
**REPLACEMENT SHEET**

Inventors: Mayer, et al.

Serial No.: 10/821,107

Sheet 7 of 12 Figure 7

**FIG 7**



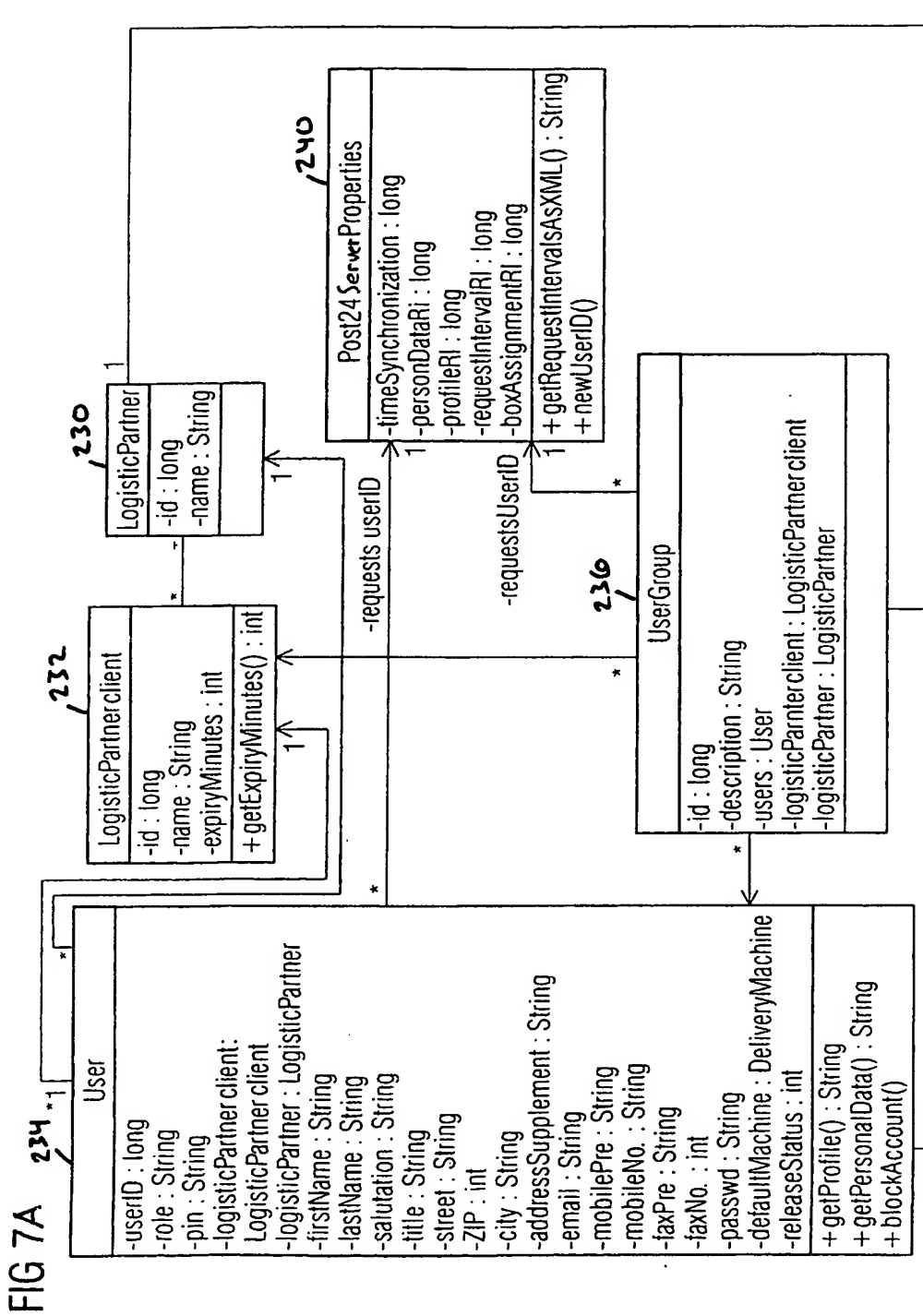


# REPLACEMENT SHEET

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Sheet 8 of 12 Figure 7A



# REPLACEMENT SHEET

Inventors: Mayer, et al.

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FIG 7B

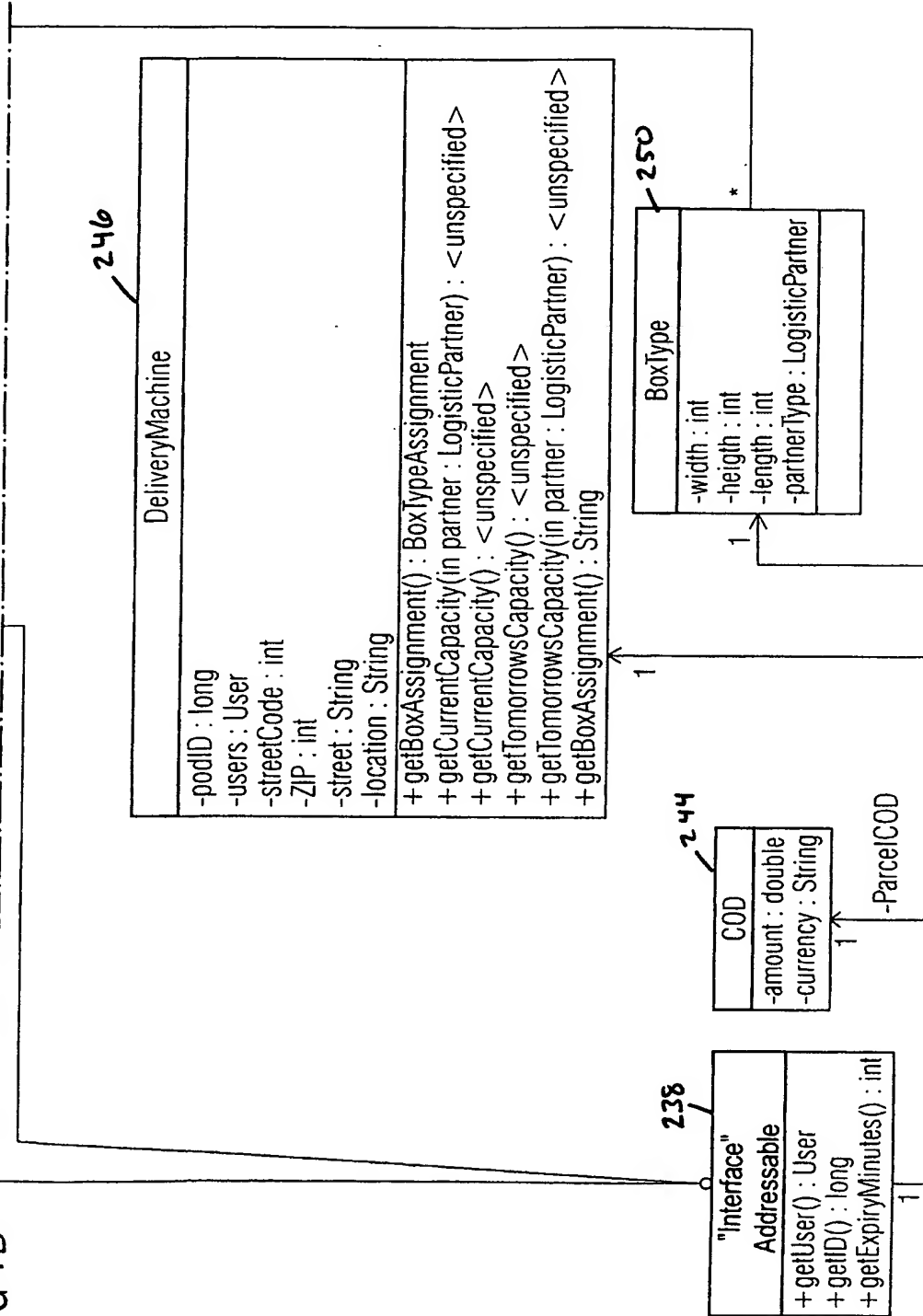


FIG 7C 1 242

| Parcel   |  |
|--|--|
| <pre> -parcelID : long -recipient : Addressable -parcelType : String -boxType : BoxType -sender : String -cod : COD -identCode : long -expiryDate : Date -slate : long -deliveryTime : Date -pickupTime : Date -machine : DeliveryMachine -substitute : Addressable -pickedUpBy : User -partnerType : LogisticPartner +getHistory() +notifyPickup(in eventTime : Date, in pickedUpBy : User, in mode : int) +getExpiryDate() : String +substituteBy(jin addressable : Addressable) +create(in podID : DeliveryMachine, in eventTime : Date, in parcelID : long, in partnerType : LogisticPartner, in parcelType : String, in indentcode : long, in customer : Addressable, in mode : Int, in cod : COD, in ???) +create(in podID : DeliveryMachine, in eventTime : Date, in parcelID : long, in partnerType : LogisticPartner, in parcelType : String, in customer : long, in customer : Addressable, in mode : Int, in boxType, in ??) +create(in podID : DeliveryMachine, in eventTime : Date, in parcelID : long, in partnerType : LogisticPartner, in parcelType : String, in indentcode : long, in customer : Addressable, in mode : Int, in cod : COD, in ???) +getRecipients() : User +getSubstitutes() : User +getProfiles() : String </pre> |  |

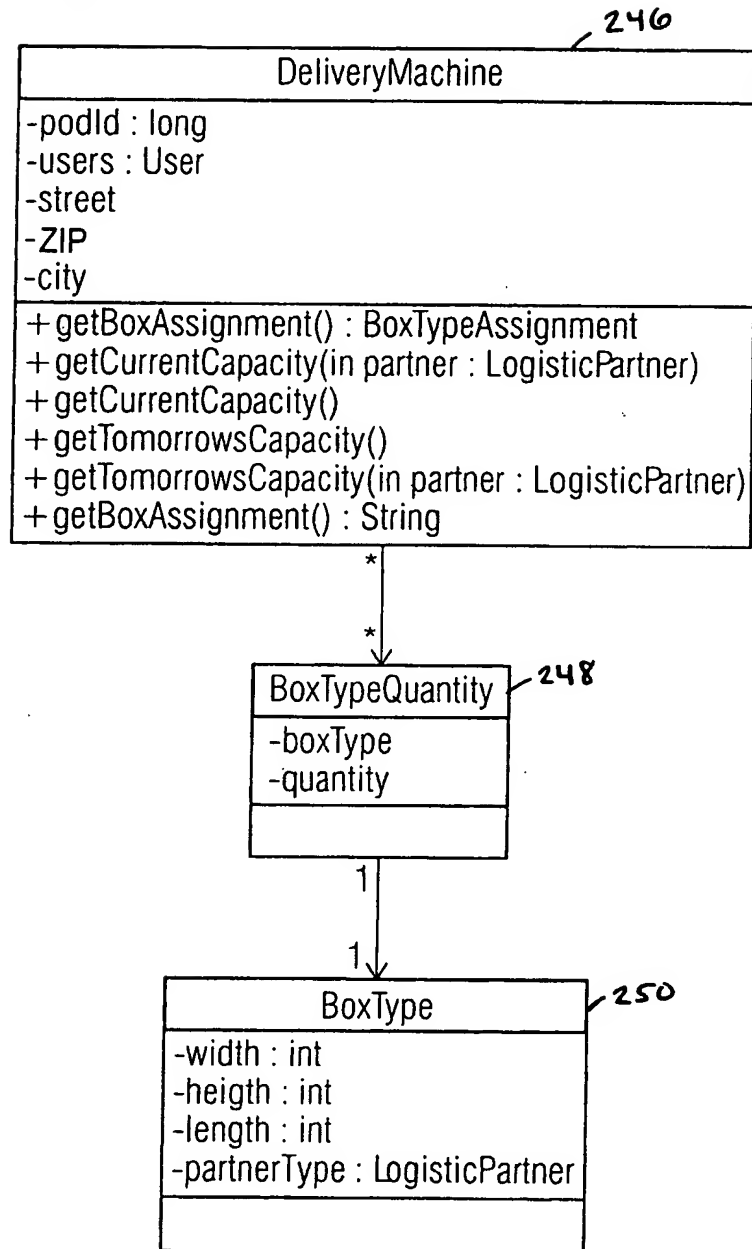
REPLACEMENT SHEET

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Sheet 11 of 12 Figure 8

FIG 8



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Inventors: Mayer, et al.

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Sheet 12 of 12 Figure 9

FIG 9

